

REMARKS

Review and reconsideration on the merits are respectfully requested.

Applicants have cancelled claims 3 and 4 and have added new claim 5 which is directed to a semiconductor wafer processing method using the removable pressure-sensitive adhesive sheet of claim 1. It is believed that at least the subject matter of original claim 3 supports new method claim 5, especially when read in light of the entirety of the specification. Therefore, no new matter has been added and entry of new claim 5 is respectfully requested.

With respect to independent claim 1, Applicants have further defined the nature of the polymer in accordance preferred aspects of the present invention. In particular, the polymer has been defined as having a weight average molecular weight of from 930,000 to 2,100,000. While this range is not expressly disclosed in the specification as a range *per se*, Reference Example 5 at page 18 constitutes an example of the molecular weight at the lower end, and Reference Example 6 at page 19 constitutes an example of the molecular weight at the upper end. These are the highest and lowest molecular weights disclosed in the Reference Examples of the specification. Based on the examples mentioned, clear support lies in the specification to amend claim 1 in the manner indicated, without introduction of new matter. Accordingly, entry of amended claim 1 is also respectfully requested.

On page 2, paragraph 2, the Examiner rejects claims 3-4 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Examiner argues that these are improper "use claims", and suggests that method claims be added.



In response, Applicants have cancelled claims 3 and 4 as indicated above, and have added new method claim 5. Accordingly, it is considered that this rejection is now moot, and its withdrawal is respectfully requested.

In paragraph 6 at pages 3-4, claims 1-4 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, alternatively, under 35 U.S.C. § 103(a) as allegedly obvious over Yamamoto et al. The Examiner notes that Yamamoto has two common co-inventors and a common assignee with the present application.

Yamamoto is based on an application filed in the United States on December 28, 1999. Applicant's earliest priority date claimed in the present application is December 14, 1999. Applicants submit herewith a sworn translation of their first priority application, Japanese Patent Application No. Hei. 11-355190 including a corresponding Declaration Under 37 C.F.R. § 1.55(b). It is believed that this priority application fully supports the subject matter of original claims 1 and 2. However, Applicants further note that Reference Examples 5 and 6, from which the molecular weight range discussed above, now recited in claim 1, is based, are not present in this first priority application. Therefore, in this regard, the claims do not have full-scope literal support in this priority document.

Nonetheless, to the extent the Examiner continues to apply the Yamamoto patent as a reference, Applicants respectfully note that Yamamoto contains no express teaching or suggestion with regard to use of a polymer having the specified content of low molecular weight components and the specified molecular weight range. Moreover, Applicants respectfully submit that Yamamoto fails to teach or suggest that the claimed low-molecular content aspect of



the present invention is a result-effective parameter in terms of improving the properties of the pressure-sensitive adhesive layer, as demonstrated by the Examples of the present invention. See the summary discussion at pages 22-23 of the specification. Accordingly, Applicants respectfully submit that the present invention is not anticipated by, and would not have been considered obvious over Yamamoto for at least these reasons. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

In paragraph 7, claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, alternatively, under 35 U.S.C. §103(a) as obvious over EP 0 818 470 A1. The Examiner appears to admit that Applicants' specifically claimed content of low-molecular components is not expressly disclosed by EP '470. Nonetheless, the Examiner's rejection appears to be based on an inherency theory, or a theory that optimizing the amount of low-molecular weight components would have been obvious to one skilled in the art.

This rejection is respectfully traversed.

The polymer disclosed in EP '470 has a weight molecular weight 10,000 to 500,000. Further, there is no express disclosure of Applicants' claimed content of low-molecular weight components. At a base minimum, in view of the amended claim language reciting the distinct molecular weight range, the anticipation rejection based on EP '470 cannot stand.

Moreover, Applicants respectfully submit that it would be improper to continue to reject the claims under 35 U.S.C. § 103(a), as obvious over EP '470. As demonstrated by the Examples in the specification, and considering the specific discussion of the results and advantages set forth in detail at pages 22-23, it is respectfully submitted that any inference of



prima facie obviousness is rebutted. In this regard, Applicants submit that EP '470 fails to recognize or appreciate that the content of the low molecular weight components is a result-effective factor. In this circumstance, the Examiner cannot legally rely on a position that it would simply have been obvious to optimize the amount thereof, since the reference fails to expressly disclose this claim element, much less suggest that it is a parameter which can be controlled to produce the advantages described in the present specification.

Accordingly, in view of the foregoing, reconsideration and withdrawal of the rejection is paragraph 7 is respectfully requested.

In paragraph 8 of the Office Action, claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP '470, taken individually or in view of De Simone et al.

Claim 4 has been cancelled as noted above. Claim 2 depends from claim 1 and is patentable over EP '470 for at least the same reasons as its base claim 1 should be found patentable, as summarized above. Accordingly, reconsideration and withdrawal of this rejection is also respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.



The USPTO is directed and authorized to charge any additional fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: September 19, 2002



APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please cancel claims 3 and 4 without prejudice or disclaimer.

Please amend claim 1 as follows:

1. (Amended) A removable pressure-sensitive adhesive sheet which comprises a pressure-sensitive adhesive layer [constituted of] comprising a pressure-sensitive adhesive comprising a polymer in which the content of low-molecular components having a molecular weight of 10^5 or lower is 10% by weight or lower, and the polymer has a weight average molecular weight of 930,000 to 2,100,000.

Please add new claim 5 shown above.